

**REMARKS**

Claims 1, 2, 4-10, and 12-21 were pending. Claims 1, 4, 5, 9, 12, 13 and 17 are amended and claim 21 is canceled. Support for the amendments to claims 1, 4, 5, 9, 12, 13 and 17 may be found in the specification and claims as originally filed. No new matter is added. As a result, claims 1, 2, 4-10, and 12-20 are pending and at issue.

**35 U.S.C. § 112 First Paragraph Rejections**

The applicants respectfully submit that the § 112 first paragraph rejections of claims 1, 2, 4-10, and 12-20 are moot in view of the amendments to claims 1, 9, and 17. The applicants respectfully request withdrawal of the rejection of claims 1, 2, 4-10, and 12-20.

**35 U.S.C. § 102 Rejections**

The applicants respectfully traverse the rejection of claims 1-8 and 17-20 as anticipated by U.S. Patent No. 4,505,388 to Solomon (“Solomon”). “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628 (Fed. Cir. 1987).

**Claims 1-8**

Each of claims 1-8 recites a file storage device having a file suspension device disposed adjacent to first and second panels, wherein a file disposed on the file suspension device is completely disposed between first and second panels. Solomon fails to disclose or suggest such a file suspension device. To the contrary, Solomon discloses an expandable portable file having two side panels, a back panel, and a bottom, however, the upper edges of the two side panels form supports for the hanging files. *See* Solomon, abstract and Fig. 3. As a result, a portion of the hanging file is disposed outside of the storage space (i.e., not between the side panels). In other words, the hangar portion of the hanging file rests on top of, and hangs over, the side panels. *See* Solomon, Fig. 3. As a result, Solomon fails to disclose or suggest a file suspension device, wherein a file disposed on the file suspension device is completely disposed between first and second panels. Therefore, none of claims 1-8 are anticipated by Solomon and the applicants respectfully request withdrawal of the rejection of claims 1-8.

Claims 17-20

Each of claims 17-20 recites a file storage device having an exterior shell and a substantially horizontal top panel, wherein an openable panel is pivotable without moving top panel. Solomon fails to disclose or suggest an openable panel that is pivotable without moving a top panel. To the contrary, as seen in Figs. 2 and 4 of Solomon, the top includes two projections that engage the front panel when the top is closed. Presumably, this structure facilitates holding “the file contents securely even when accidentally tipped or dropped,” which is an object of the Solomon disclosure. *See* Solomon, col. 1, lines 54-55. Therefore, the front panel is restricted from pivoting when the top is closed. In other words, a user must lift the top before the front panel may be moved. As a result, Solomon fails to disclose or suggest an openable panel that is pivotable without moving the top panel. The applicants respectfully request withdrawal of the rejection of claims 17-20.

**35 U.S.C. § 103 Rejections**

The applicants respectfully traverse the rejection of claims 9-16 as obvious over Solomon in view of U.S. Patent No. 4,666,047 to Fletcher. To establish a *prima facie* case of obviousness, “the prior art reference (or references when combined) must teach or suggest all the claim limitations.” M.P.E.P. § 2143. The cited art fails to disclose or suggest all claim limitations. In particular, each of claims 9-16 recites a file storage device having a file suspension device disposed adjacent to first and second panels, wherein a file disposed on the file suspension device is completely disposed between first and second panels. As shown above, Solomon fails to disclose or suggest such a file suspension device.

Fletcher also fails to disclose or suggest such a file suspension device, nor was Fletcher cited as disclosing such an element. Fletcher is cited solely to show “a series of notches.” *See* the official action, page 5. Regardless, Fletcher fails to show a file suspension device of any sort. Rather, Fletcher discloses suspension rails and hangars that “facilitate examination of the sheets and drawings which are suspended from the hangers.” Emphasis added, *see* Fletcher, col. 4, lines 8-11. Thus, Fletcher fails to cure the deficiency of Solomon and for this reason, the rejection of claims 9-16 should be withdrawn.

Moreover, there is no motivation to combine the teachings of Solomon and Fletcher. The alleged motivation (Fletcher, col. 4, lines 4-15) makes no mention of “files.” Rather,

Fletcher discloses hanging “sheets” or “drawings,” neither of which are files, let alone hanging files. Furthermore Fletcher does not disclose notches in a file suspension support (as alleged), the notches 44 are formed in the front and back stationary rails 18, 20, and suspension rails 52 are attached to the stationary rails 18, 20. Thus, Fletcher does not teach notches in a “file suspension support,” because the sheets and drawings are not suspended from the stationary rails 18, 20, the sheets and drawings are suspended from the suspension rails 52. For this additional reason, the rejection of claims 9-16 is improper and should be withdrawn.

### **Conclusion**

In view of the above amendments, the pending application is in condition for allowance. If, in the opinion of the examiner, a telephone conference would expedite prosecution of the subject application, the examiner is invited to call the undersigned.

Enclosed is a check in the amount of \$120.00 and a petition for a one month extension of time. No other fees are believed due. However, the director is hereby authorized to charge any deficiency in the fees filed, asserted to be filed or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Deposit Account No. 13-2855, under Order No. 29618/39225.

Respectfully submitted,

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